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PATENT,

(Practitioner's Docket No. IN- 5453)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

HINTZE-BRÜNING et al.

Serial No.: 09/762,030

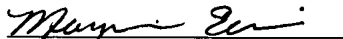
Filed: January 31, 2001

For: FILM AND THE USE THEREOF
FOR COATING SHAPED PARTS

Group Art Unit: Not Assigned

Examiner: Not Assigned

I hereby certify that the attached correspondence is being deposited with the United States Postal Service in an envelope as First Class Mail addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on March 7, 2001.



Marjorie Ellis



**COMMUNICATION FOR SUBMITTING THE ENGLISH TRANSLATION OF THE
INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

Hon. Assistant Commissioner for Patents
Washington, DC 20231

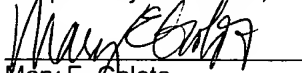
Sir:

Submitted herewith is a copy of the English Translation of the International Preliminary Examination Report for the above- mentioned application.

Applicant believes that no fee is required. However, if applicant has inadvertently overlooked the need for a fee the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 23-3425.

This form is submitted in triplicate.

Respectfully Submitted,


Mary E. Golota
Registration No. 36,814

Date: March 7, 2001
BASF Corporation
26701 Telegraph Road
Southfield, Michigan 48034-2442
(248)-948-2020

Translation

PATENT COOPERATION TREATY

PCT

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference PAT 98131 PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/HP/EA/416)	
International application No. PCT/EP99/05180	International filing date (day/month/year) 21 July 1999 (21.07.99)	Priority date (day/month/year) 04 August 1998 (04.08.98)
International Patent Classification (IPC) or national classification and IPC C08J 7/04		
Applicant BASE COATINGS AG		



1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 3 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 24 February 2000 (24.02.00)	Date of completion of this report 18 October 2000 (18.10.2000)
Name and mailing address of the IPEA/EP Facsimile No.	Authorized officer Telephone No.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP99/05180

I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- ☒ the international application as originally filed.
- ☒ the description, pages 1-32, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____,
pages _____, filed with the letter of _____.
- ☒ the claims, Nos. 1-12, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. _____, filed with the letter of _____,
Nos. _____, filed with the letter of _____.
- ☐ the drawings, sheets/fig _____, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig _____, filed with the letter of _____,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

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International application No.
PCT/EP 99/05180

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-9, 11, 12	YES
	Claims	10	NO
Inventive step (IS)	Claims	1-9, 11, 12	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-12	YES
	Claims		NO

2. Citations and explanations

1. Novelty and inventive step

- 1.1 JP-A-53 091 943 (D1; see the corresponding DATABASE WPI Abstract) describes a coating method in which an article is first provided with a solvent-based paint and then coated with a coating powder, such as curing epoxide or urethane.

JP-A-11 047 686 (D2; see the corresponding Patent Abstract of Japan) discloses a coating method for car parts in which heat-curable coating powder is applied to a base material (and two other layers) and pre-dried. A water-dilutable coating is then applied.

The subject matter concerning the films as per Claims 1-8 and the method Claims 9 and 11, as well as the use as per Claim 12, differs from D1 and D2 obviously in that it concerns a prefabricated film with at least two layers, one of which comprises the heat-curable coating powder, while in D1 and D2 coating is carried out layer after layer.

Consequently, the subject matter of the application should be considered novel and inventive in relation

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to the available prior art.

- 1.2 Regarding the end products coated with the prefabricated film, as defined in Claim 10, it is not clear how the end products obtained according to D1 and D2 differ therefrom, since they also comprise at least two layers (one of which containing a coating powder).

Moreover, the coatings of D1 and D2 comprise at least one layer which fulfils the function of a backing layer as defined in Claim 1. It is therefore not clear how the end products coated with the prefabricated films differ structurally from the prior art end products (PCT Article 33(2)).

Novelty could possibly be established by a different definition of the backing layer. In this case, an inventive step would also be recognised.